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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,279	02/09/2001	A. Buell Ish III	500783.01	8038

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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

MATHEW, FENN C

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,279

Applicant(s)

ISH, A. BUELL

Examiner

Fenn Mathew

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-23 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-23 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Claims 24-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 2-3, 5-15, 18-21, 23, 36-39, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Voris (U.S. Patent No. 4,357,011). Referring to claim 6, Voris discloses a pad assembly comprising a compressible layer (64) having a first surface adapted to engage a portion of a user's body and a second surface opposite from the first surface, a backing member (52) having a non-planar surface engaged with the second surface of the compressible layer, and wherein the non-planar surface of the backing member is shaped to provide an approximately uniform-thickness portion of the compressible layer when a compression force is applied to the first surface during an exercise.
4. Referring to claim 2, Voris discloses the backing member comprising a contoured support attached to the second surface.
5. Referring to claim 3, Voris discloses the device wherein the non-planar surface comprises a contoured portion that provides a compressed shape of the compressible

layer that approximately corresponds with an anticipated shape of the portion of the user's body.

6. Referring to claim 5, Voris discloses a device wherein the first surface comprises a concave portion adapted to engage a portion of the user's body.

7. Referring to claim 6, Voris discloses a device wherein the non-planar surface of the backing member is shaped to provide an approximately uniform-thickness portion of the compressible layer when a compression force is applied to the first surface during an exercise.

8. Referring to claim 7, Voris discloses a device wherein the approximately uniform-thickness portion is co-extensive with a portion of the first surface adapted to engage a the portion of the user's body.

9. Referring to claim 8, Voris discloses a device wherein the non-planar surface of the backing member is shaped to provide an approximately uniform-pressure portion when a compression force is applied to the first surface during an exercise. (Column 5, lines 5-10)

10. Referring to claim 9, Voris discloses a device wherein the backing member comprises a coupling assembly adapted to attach to an exercise machine.

11. Referring to claim 10, Voris discloses a device wherein the backing member comprises a contoured backing plate.

12. Referring to claim 11, Voris discloses a device wherein the backing member comprises an axisymmetric member. (See figs. 6, 7).

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13. Referring to claims 12-15, 18-21, 23, 36-39, and 41. Please see paragraphs 15-28 in the office action dated September 8, 2002.

Claim Rejections - 35 USC § 103

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 4, 16-17, 22 and 40 rejected under 35 U.S.C. 103(a) as being unpatentable over Voris (U.S. Patent No. 4,357,011). Referring to claim 4, Voris has disclosed the claimed invention except for the exact range of the radius of curvature of the contoured portion. The feature of having the radius of curvature of the contoured portion fall within the range of 1.5 inches and 7.0 inches is a matter of design choice, wherein no stated problem is solved, nor any unexpected result attained using the radius of curvature of the Voris device.

16. Referring to claims 16-17, 22 and 40, please see paragraphs 31-33 of the office action dated September 18, 2002.

Response to Arguments

17. Applicant's arguments filed December 11, 2002 have been fully considered but they are not persuasive. Applicant has argued that Voris does not explicitly state that the backing member is not shaped to provide a uniform-thickness portion of the compressible layer when a compression force is applied. The backing member of Voris

is concave, and thus when a limb compresses the compressible layer, it will naturally assume a concave shape as a consequence. (See fig. 6)

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fenn Mathew whose telephone number is (703) 305-2846. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm.

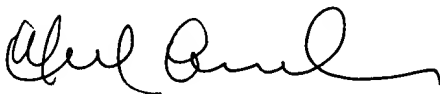
The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



**NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
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fc-m
fcm

February 20, 2003